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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,461	02/20/2001	Masahiro Nozaki	P 277124 T36-129082M/AIO	5463
23400	7590	11/03/2004	EXAMINER	
POSZ & BETHARDS, PLC 11250 ROGER BACON DRIVE SUITE 10 RESTON, VA 20190			STRIMBU, GREGORY J	
			ART UNIT	PAPER NUMBER
			3634	

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/785,461	<b>Applicant(s)</b> NOZAKI, MASAHIRO 	
	<b>Examiner</b> Gregory J. Strimbu	<b>Art Unit</b> 3634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 2 and 4-11 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 4, 5 and 8-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

Applicant's election with traverse of restriction requirement in Paper No. 4 is acknowledged. The traversal is on the ground(s) that subject matter of all of the species is sufficiently related that a thorough search for the subject matter of any one species would necessarily encompass a search for the remaining species. This is not found persuasive because the allegations listed above show that the applicant has not analyzed the examiner's action in the context of the established practice for requiring an election of species as set forth in chapter 800 of the MPEP. It is a well established practice that a requirement to elect a single species is a holding by the examiner that the plural species, as claimed, are patentably distinct (i.e., capable of supporting separate patents). See MPEP 808.01(a) and MPEP 809.02(a). If the applicant is of a different view, the applicant need merely clearly state on the record that the species are not patentably distinct. Neither the examiner nor the applicant needs to present any reasoning. Of course, it should be noted that the species that are not patentably distinct are obvious in view of one another. Applicant's response implies that the various species are not considered to be patentably distinct. If this is the case, then the applicant must clearly admit such on the record. The requirement is still deemed proper and is therefore made FINAL.

Claims 6 and 7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 4.

### ***Drawings***

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on August 2, 2002, October 1, 2003 and Jun3 1, 2004 have been approved.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4, 5 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in figure 11 and Vaughan et al.

The admitted prior art in figure 11 discloses a trim and glass run attachment structure in a vehicle door comprising, a flange part (not numbered, but seen in figure 11) provided on a window frame 13 of the vehicle door, wherein the window frame is comprised by an inner panel 15, an outer panel 16 and a door sash 17, and the flange part is comprised by a portion of the window frame at which an interior flange 15b of the inner panel and an interior flange 17a of the door sash are joined together and to which a trim 31 is mounted, a U-shaped attachment groove 17c, which is adjacent to and integral with the proximal end of the flange part, wherein the U-shaped attachment groove is on an exterior side of the proximal end of the flange part and is on an outer peripheral side of the proximal end of the flange part, a lock protrusion strip 17d

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provided on a wall of the attachment groove that is on an interior side of the attachment groove, and the lock protrusion strip 17d is at the proximal end of the flange part, and a glass run 31a, wherein the glass run has a glass run body (not specifically numbered, but shown in figure 11) attached to the attachment groove, wherein the glass run body includes opposing side walls (not numbered, but shown in figure 11) and a pair of seal lips 31b and 31c, one seal lip 31b of the pair of seal lips being on the door interior side of the window glass and one seal lip 31c of the pair of seal lips being on the door exterior side of the window glass, and wherein the seal lips are structured to engage opposing sides of a window glass 14, and wherein the glass run body has a lock protrusion strip (not numbered, but shown in figure 11) engaging with the lock protrusion strip of the attachment groove to retain the glass run body in the groove, and a door exterior part of the flange part and a door interior part of the attachment groove are integrally formed as a single component, and wherein the flange part and attachment groove are formed in series and are portioned by the lock protrusion strip of the attachment groove. The admitted prior art of figure 11 is silent concerning a glass run formed separately from the trim.

However, Vaughan et al. discloses a trim and glass run attachment structure comprising a trim (not numbered, but shown in figure 3) formed separately from a glass run 26 wherein a part of the trim (not numbered, but seen in figure 3) is in contact with part 126 of the glass run when the trim is attached to a flange part 60.

It would have been obvious to one of ordinary skill in the art to provide the admitted prior art of figure 1 with a trim formed separately from the glass run, as taught

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by Vaughan et al., to reduce the cost of manufacturing the trim and glass run attachment structure since the provision of a separate trim enables the sealing assembly to accommodate greater stamping irregularities.

### ***Response to Arguments***

Applicant's arguments filed June 1, 2004 have been fully considered but they are not persuasive.

With respect to the applicant's comments concerning the motivation to combine the teachings of Vaughan et al. with the admitted prior art of figure 11, the examiner respectfully disagrees. As noted above, providing the admitted prior art of figure 11 with a separate trim element enables the sealing assembly to accommodate greater stamping irregularities. In other words, the position of the interior flange with respect to the attachment groove need no be as accurate since the a separate trim member would be able to accommodate said irregularities without reducing the aesthetics of the sealing assembly or reducing the sealing ability of the sealing assembly. Note that the trim member of Vaughan et al. overlaps the glass run permitting the position of the glass run with respect to the trim to vary without a degradation in sealing ability or aesthetics.

With respect the applicant's comments concerning Vaughan et al. individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It should be noted that Vaughan et al. is merely used for the teachings of

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providing a sealing assembly having a separate trim member and glass run. The mere fact that Vaughan et al. provides a separate trim member and glass run for a different reason than set forth above does not prevent Vaughan et al. from being used as a reference.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 703-305-3979. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Gregory J. Strimbu", with a stylized flourish at the end.

Gregory J. Strimbu  
Primary Examiner  
Art Unit 3634  
November 1, 2004